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EXAMINER

SALIMI, ALI REZA

ART UNIT

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1648

NOTIFICATION DATE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## **DETAILED ACTION**

### ***Response to Amendment***

This is a response to the amendment filed 1/08/09, and 4/09/2009. Claims 2-8, 11-42, 44-72 have been canceled. Claims 1, 9, and 10 have been amended by the Applicants in response To Offices' previous Action mailed 07/09/2008. Claims 73-117 have been added. Claims 1, 9, 10, 43, 73-117 are pending before the examiner.

### ***Claim Rejections - 35 USC § 102***

In view of Applicants extensive amendment to the claims and modification of claimed invention the previously stated rejections are now moot.

### **New Grounds of Rejection:**

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 9, 10, 43, 73-117 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 70-72, 77-79, 82-99, 101-132 of copending Application No. 10/751,845. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope.

In addition, the subject matter of the claims are so closely related that would incorporate overlap species and/or claims of ,845 are so broadly drafted that would incorporate any and all species that is present in current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented/published.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a **written description** of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 9, 10, 43, 73-117 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant disclosure, Applicants have only disclosed small fragments of hybrid polypeptides. No other sequences which “comprise, comprises, or comprising” nucleic acids as now claimed were disclosed. The specification does not set forth the metes and bounds of that encompasses, and there is not enough information about it in literature either to guide the one of ordinary skill in the art to

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predict the undisclosed regions where the region may encompass. Therefore, a written description of the other nucleic acid claimed sequences should be disclosed to overcome this rejection. See also *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398 (Fed. Cir. 1997), which teaches that the disclosure of a process for obtaining cDNA from a particular organism and the description of the encoded protein fail to provide an adequate written description of the actual cDNA from that organism which would encode the protein from that organism, despite the disclosure of a cDNA encoding that protein from another organism. 35 USC 112 requires inter alia that a patent specification contain a written description of the invention and the manner and process of making and using it "in such full clear and concise terms as to enable one skilled in the art ... to make and use" the invention. Case law has made it clear that the requirements for a "written description" and an "enabling disclosure" are separate. For example, where a specification contains sufficient information to enable a skilled chemist to produce a particular compound because it gives detailed information on how to produce analogous compounds but it makes no reference to the compound in question, the "written description" requirement has not been met even though the description may be enabling.

See *University of California v. Eli Lilly*, 19 F.3d 1559, 43 USPQ 2d 1398 (Fed. Cir. 1997):

The name cDNA is not in itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA .... Accordingly, the specification does not provide a written description of the invention ....

and at pg 1406:

a generic statement such as "vertebrate insulin cDNA" or "mammalian insulin cDNA," without more, is not an adequate written description of the genus because it does not distinguish the genus from others, except by function. It does not specifically define any of the genes that fall within its definition. It does not define any structural features commonly possessed by members of the genus that distinguish them from others. One skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. A definition by function, as we have

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previously indicted, does not suffice to define the genus because it is only an indication of what the genes does, not what it is.

See *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ 2d 1016 at page 1021:

A gene is a chemical compound, albeit a complex one, and ... conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials .... Conception does not occur unless one has a mental picture of the structure of the chemical or is able to define it by its method of preparation, its physical or chemical properties, or whatever characteristics sufficiently distinguish it. It is not sufficient to define it solely by its principal biological property, *e.g.*, encoding human erythropoietin, because an alleged conception having no more specificity than that is simply a wish to know the identity of any material with that biological property.

Additionally, the specification as filed fails the standard of written description.

Applicants have provided a wish list and the disclosure fails to provide adequate teaching under the quid pro quo doctrine.

The goal of written description requirement is “to clearly convey the information that an applicant has invented the subject matter which is claimed”, see *In re Barker*, 559 F.2d 588, 592 n.4 (CCPA 1977). The inventor has an obligation under “written description” to disclose the technologic knowledge upon which the patent is based and to demonstrate that the patentee was in possession of the invention that is claimed. See *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005). In the instant disclosure, Applicants have made broad statements and more or less a wish list for others to conduct research. Applicant cannot enjoy the fruit of excluding others from practicing the invention for a limited period of time without providing the public meaningful disclosure. See *Ariad Pharmaceutical Inc., v. Eli Lilly* (Fed. Cir. 2009)

Here, Applicants’ teachings do not commensurate with the scope of patent protection. Applicants were not in possession of all types of comprising nucleic acid sequences. The disclosure does not possess what it claims. The specification does not set forth the metes and bounds of that encompass, and there is not enough information about it in literature either to

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guide the one of ordinary skill in the art to predict the undisclosed regions where the region may encompass. Thus, the disclosure fails to provide a meaningful disclosure and possession of the broad scope of the now claimed invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 10, 43, 73-117 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hedley et al (WO 01/019408).

The above cited reference long before Applicants' claimed priority disclosed nucleic acid encoding a hybrid polypeptide comprising a signal sequence wherein the product can be utilized in a method for inducing immune response and treatment of cancer in general and papillomavirus in particular (see the abstract, pages 9-12, 28-29 and the claims).

Applicants are reminded that limitation of “being less than 25 of age” has no patentable weight, because Hedley et al broadly taught inducing immune response in a mammal which includes human host and that comprises the now intended age limit. Having said that, the above cited reference teaches administering the composition to an “adult human”, which reads on the now claimed limitation (see page 29, lines 4-7). A specification need not teach, and preferably omits, what is well known in the art. See, Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

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Additionally, under inherency doctrine where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of anticipation has been established. See, In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Still further, the fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention. See, Toro Co. v. Deere & Co., 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004).

Moreover, applicants are directed to In re Cruciferous Sprout Litigation, 64 USPQ2d 1202 (CA FC 2002), "a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it." The court said, "While Brassica may have recognized something quite interesting about those sprouts, it simply has not invented anything new." This is the case here, while the Applicants may have "Observed" something interesting they have not invented anything new.

No claims are allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached on (571) 272-0832. The Official fax number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/A R Salimi/

Primary Examiner, Art Unit 1648

05/04/2009